

REMARKS

The Office Action mailed 10/06/2004 has been carefully considered. Reconsideration of this application, in view of the following remarks, is respectfully requested.

Amendments to the Specification and Drawings

As required in paragraph 2 of the Office Action, a substitute specification (without claims or abstract) in compliance with 37 CFR 1.125 has been provided with this Amendment. A marked-up copy of the substitute specification showing the changes made to the immediately prior version of the specification has also been provided. No new matter has been added to this application as a result of the changes made to the specification.

As requested in paragraph 1 of the Office Action, the substitute specification provides the correct application numbers (and issued US patent numbers where appropriate) for the related applications that are cited on page 1 and referenced elsewhere in the specification.

The Office Action did not list any additional specific problems with the specification. The undersigned has reviewed the specification for grammatical and spelling errors and language informalities, and has made appropriate correction to the best of his ability. The correction made in paragraph [0038] of the substitute specification, which changes the word “translated” to “decoded”, is made to conform the text of the specification to the text in box 525 of Figure 6.

The Claims

Claims 1 – 10 are pending in this application, including independent claims 1 and 5. Claims 1, 2, 4 – 5, 7, and 9 – 10 have been amended. Support for the amendments to independent claim 1 may be found in paragraphs [0018], [0020], [0023] and [0024] (with reference to the substitute specification).

Amendments to claims 2, 4, 7, 9 and 10 conform the language in these claims to the revised claim language in independent claims 1 and 5.

35 U.S.C. 103(a)

Claims 1 and 2

In the Office Action, claims 1 – 2 were rejected, in paragraph 2, under 35 U.S.C. § 103(a) as being unpatentable over Grefenstette (US 6,396,951), in view of Raman (US 5,828,885). Claims 3 – 4 and 9 were rejected, in paragraph 3, under 35 U.S.C. § 103(a) as being unpatentable over Grefenstette (US 6,396,951), in view of Raman (US 5,828,885), in further view of Hecht (US 5,221,853). Claims 5, 7, 8 and 10 were rejected, in paragraph 4, under 35 U.S.C. § 103(a) as being unpatentable over Grefenstette (US 6,396,951). Claim 8 was rejected, in paragraph 5, under 35 U.S.C. § 103(a) as being unpatentable over Grefenstette (US 6,396,951) in view of Greene et al. (US. 6,628,837). Claim 6 was rejected, in paragraph 6, under 35 U.S.C. § 103(a) as being unpatentable over Grefenstette (US 6,396,951), as applied to claim 5 above, in view of Hecht (US 5,221,853).

These rejections are all respectfully traversed, in view of the following arguments, because a *prima facie* case of obviousness has not been made in the Office Action for any of these claims.

The Grefenstette patent issued May 28, 2002, after the 12/18/2000 filing date of the subject application. Therefore, the Grefenstette patent qualifies as art under 35 U.S.C. § 102(e)(2) because of its prior filing date of 12/23/98 (i.e., “§ 102 ... (e) the invention was described in ... (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent...”). However, the Grefenstette patent is owned by Xerox Corporation, the same assignee as the subject application. It is respectfully submitted that, under 35 U.S.C. § 103(c), effective for applications filed on or after November 29, 1999, the Grefenstette patent is not eligible as a reference to

be combined with the Raman reference in an obviousness rejection under 35 U.S.C. § 103(a) for the subject application. See MPEP 706.02(I)(1).

The undersigned herein states that Application 09/738,291 and US Patent 6,396,951 issued to Grefenstette were owned by Xerox Corporation at the time the invention of Application 09/738,291 was made.

The Greene patent issued September 30, 2003, after the 12/18/2000 filing date of the subject application. Therefore, the Greene patent also qualifies as art under 35 U.S.C. § 102(e)(2) because of its prior filing date of 5/19/2000. However, the Greene patent is owned by Xerox Corporation, the same assignee as the subject application. It is respectfully submitted that, under 35 U.S.C. § 103(c), effective for applications filed on or after November 29, 1999, the Greene patent is not eligible as a reference to be combined with the Grefenstette reference in an obviousness rejection under 35 U.S.C. § 103(a) for the subject application. See MPEP 706.02(I)(1).

The undersigned herein states that Application 09/738,291 and US Patent 6,628,837 issued to Greene were owned by Xerox Corporation at the time the invention of Application 09/738,291 was made.

For the foregoing reasons, is believed that the Office Action fails to state a *prima facie* case of obviousness under 35 U.S.C. § 103(a) with respect to claims 1 - 10. For this reason, Applicants respectfully request that all of the rejections to claims be withdrawn.

Reconsideration Requested

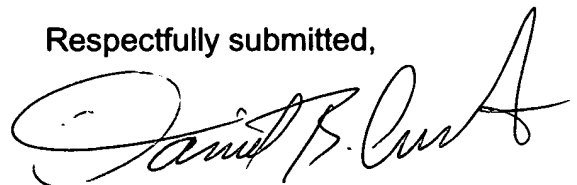
The undersigned respectfully submits that, in view of the foregoing remarks, the rejections of the claims raised in the Office Action have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that these claims be allowed, and that this case be passed to issue.

PATENT

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation authorized attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefore to Xerox Corporation Deposit Account No. 24-0025.

Should any additional issues remain, or if I can be of any additional assistance, please do not hesitate to contact me at (650) 812-4259.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Daniel B. Curtis", with a large, stylized capital "A" at the end.

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Attachments: Substitute Specification (no Claims or Abstract)

Marked-Up Version of Substitute Specification (no Claims or
Abstract)